

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of	)	
Trademark Registration No. 2,772,766	)	
For the Mark SAN DIMAS GUITARS THE	)	
CALIFORNIA GUITAR COMPANY (Design)	)	
Registration Date: October 7, 2003	)	
	)	
JACKSON/CHARVEL MANUFACTURING,	)	Cancellation No. 92042614
INC.,	)	
Petitioner,	)	
	)	
v.	)	
	)	
PRINS, LLOYD A.,	)	
Registrant-Respondent.	)	

**PETITIONER'S REPLY IN SUPPORT OF ITS MOTION TO COMPEL AND TO TEST  
SUFFICIENCY OF RESPONSE TO ADMISSION REQUESTS**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel"), replies to Lloyd A. Prins' ("Prins") belated response brief filed over three weeks after it was due.

**I. PRINS' RESPONSE BRIEF IS UNTIMELY AND SHOULD BE DISREGARDED.**

Jackson/Charvel served its Motion to Compel on December 31, 2004. Prins had 20 days in which to file a response brief to the Motion to Compel. Accordingly, Prins response was due on January 20, 2005. Prins did not file a response until February 14, 2005. "When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded . . . ." 37 C.F.R. § 2.127(a); *see also* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 502.04, at 500-14 to 15 (2d ed., 1st rev. 2004); *Boston Chicken Inc. v. Boston Pizza*

**CERTIFICATE OF MAILING 37 C.F.R. 1.10**

I hereby certify that the enclosed Petitioner's Reply in Support of Its Motion to Compel and To Test Sufficiency of Response to Admission Requests and postcard are being deposited with the United States Postal Service with sufficient postage, using United States Postal Service's Express Mail Post Office to Addressee service, addressed to: U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313 on the date indicated below.

Dated: March 7, 2005

  
Salvador K. Karottki

*International Inc.*, 53 U.S.P.Q.2d 1053, 1054 (T.T.A.B. 1999) (granting summary judgment motion on respondent's counterclaims as conceded when respondent failed to file a response brief, and dismissing respondent's counterclaims with prejudice).

Prins' brief claims that he did not file a response brief because the Trademark Trial and Appeal Board ("TTAB") suspended proceedings on January 14, 2005. (*See* Prins' Response Brief [hereinafter "Resp. Br."] at 4-5.) He also states that he called the TTAB on February 10, 2005, and during his *ex parte* call, the TTAB granted him leave to file the brief based on his belief that the TTAB's suspension did not allow him to respond. (*See id.* at 5.) Prins' unsupported statements, however, do not excuse his failure to file a timely response brief. Prins' response brief was due on January 20, 2005. Jackson/Charvel's counsel did not receive the TTAB's Notice of Suspension until January 21, 2005—*after* Prins' response deadline. (*See* Declaration of Salvador K. Karottki [hereinafter "Karottki Decl."], attached hereto as Exhibit 1, at ¶¶ 9, 11 & Ex. A.) Prins cannot use the TTAB's suspension of proceedings as an excuse for failing to file a response brief if the parties did not receive notice of the suspension until *after* Prins' response brief was due. Prins' citation to the TTAB's suspension of proceedings is nothing more than a *post hoc* justification several weeks later for Prins' failure to respond. (*See* Karottki Decl. at ¶ 12.)

**II. EVEN IF PRINS' RESPONSE BRIEF IS ACCEPTED, IT IS WHOLLY DEVOID OF SUBSTANCE.**

Even if the TTAB accepts Prins' response brief, the brief is wholly devoid of substance. Of the 19 Interrogatory Requests, 9 Document Requests, and 5 Admission Requests that were addressed in Jackson/Charvel's Motion to Compel, Prins response addresses only 2 discovery requests—Admission Requests Nos. 11 and 38. Because Prins' does not make any

arguments concerning the lion's share of Jackson/Charvel's Motion to Compel, the TTAB should treat those undisputed portions of the Motion to Compel as conceded.

As discussed below, Prins' arguments concerning the only 2 discovery responses that he addresses are also meritless.

**A. Jackson/Charvel's Admission Request No. 11 Should Be Deemed Admitted.**

In his response brief, Prins states that Jackson/Charvel's Admission Request No. 11 that "Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2003" was properly denied because it requires that Prins admit that Jackson/Charvel's use of SAN DIMAS in 2003 was trademark use. (Resp. Br. at 4.) This is inaccurate. As stated in Jackson/Charvel's Motion to Compel, Jackson/Charvel defined the term "mark" in its Admission Requests to include "trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities." (Exhibit C to Jackson/Charvel's Motion to Compel [hereinafter "Motion"] at p. 2.) This definition of "mark" does not require that Prins admit that such use by Jackson/Charvel in 2003 was trademark use.

Regardless, however, in his response brief, Prins clearly states that Jackson/Charvel's use was trademark use. Prins states that he acknowledged that Jackson/Charvel "incorporated the term 'San Dimas' onto a decal that was applied to a guitar in 2003." (Resp. Br. at 4.) This *is* trademark use. In fact, Prins's answer to Jackson/Charvel's Interrogatory No. 23 states that Jackson/Charvel attempted to use the term "SAN DIMAS" "*in a trademark*" in 2003. (See Exhibit D to Motion at pp. 11-12 (emphasis added).) Prins' argument in his response brief is without merit, and the TTAB should deem Admission Request No. 11 as admitted.

**B. Jackson/Charvel's Admission Request No. 38 Should Be Deemed Admitted.**

In his response brief, Prins states that Jackson/Charvel's Admission Request No. 38 that "Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion with Jackson/Charvel's SAN DIMAS mark" could not be admitted or denied because he has no knowledge of whether Jackson/Charvel has priority over Prins. (Resp. Br. at 4.) This response is wholly meritless. Jackson/Charvel's Admission Request No. 38 says *nothing* about priority; it merely asks whether a likelihood of confusion exists between the two marks. Indeed, Prins admits that there is a likelihood of confusion between his mark and Jackson/Charvel's mark when Prins assumes that he has priority. (Exhibit D to Motion at pp. 9-10.) Prins cannot have it both ways. This proceeding would be significantly simplified if Prins admitted Request No. 38. Both parties would be able to focus their attention and resources on contested issues concerning priority and protectability if Prins truthfully answered Jackson/Charvel's request. Prins' argument that he cannot admit or deny a likelihood of confusion between the two marks is disingenuous. The TTAB should deem Admission Request No. 38 as admitted.

**III. JACKSON/CHARVEL MADE A GOOD FAITH EFFORT TO RESOLVE THIS DISCOVERY DISPUTE AND, MONTHS LATER, PRINS HAS STILL NOT SUBSTANTIVELY RESPONDED.**

In his response brief, Prins makes several statements that are false in order to give the impression that he has tried to work in good faith to resolve the issues in Jackson/Charvel's Motion to Compel. For example, Prins states that counsel for Jackson/Charvel agreed to allow him until February to respond to Jackson/Charvel's Rule 37 letter. (See Resp. Br. at 2.) This statement is false; Jackson/Charvel's counsel stated the opposite. (See Karottki Decl. at ¶ 6.)

Prins also states that Jackson/Charvel did not make a good faith effort to try to resolve the issues in Jackson/Charvel's Motion to Compel. (Resp. Br. at 3.) To the contrary, as

outlined in Jackson/Charvel's counsel's attached Declaration, Prins made it clear that he thought many of Jackson/Charvel's discovery requests were "outside of the scope" of Jackson/Charvel's Petition for Cancellation prior to Jackson/Charvel filing its Motion to Compel. (See Karottki Decl. at ¶¶ 3-5.) Jackson/Charvel sent Prins a detailed letter and counsel spoke with him on the telephone. (See *id.*) Moreover, it has been *over two months* since Prins has had Jackson/Charvel's Motion to Compel, not to mention Jackson/Charvel's Rule 37 letter, and Prins has not responded to any of the issues raised therein, except for the 2 Admission Requests noted above.

If Prins is trying to cooperate to resolve this discovery dispute, Jackson/Charvel is unaware of it, because Prins will not even respond regarding these issues. This has been the norm with Prins' approach to discovery thus far, as Prins has failed to cooperate on entering into a Confidentiality Stipulation and Protective Order. (See Karottki Decl. at ¶ 13 & Group Ex. B.) Jackson/Charvel made a good faith effort to resolve this discovery dispute and is still willing to try to resolve issues prior to the TTAB's ruling on the parties' Motions to Compel; however, Prins and Jackson/Charvel have thus far been unable to come to a resolution on the issues addressed in Jackson/Charvel's Motion to Compel.

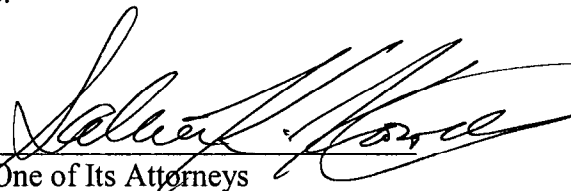
#### IV. CONCLUSION

For the foregoing reasons and those outlined in Jackson/Charvel's Motion to Compel, the TTAB should grant Jackson/Charvel's Motion to Compel in its entirety.

DATED: March 7, 2005

Respectfully Submitted,

JACKSON/CHARVEL MANUFACTURING,  
INC.

By   
One of Its Attorneys

Oscar L. Alcantara  
Salvador K. Karottki  
GOLDBERG, KOHN, BELL, BLACK,  
ROSENBLOOM & MORITZ, LTD.  
55 East Monroe Street, Suite 3700  
Chicago, Illinois 60603  
(312) 201-4000

# **EXHIBIT 1**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of	)	
Trademark Registration No. 2,772,766	)	
For the Mark SAN DIMAS GUITARS THE	)	
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Registration Date: October 7, 2003	)	
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JACKSON/CHARVEL MANUFACTURING,	)	Cancellation No. 92042614
INC.,	)	
Petitioner,	)	
	)	
v.	)	
	)	
PRINS, LLOYD A.,	)	
Registrant-Respondent.	)	

**DECLARATION OF SALVADOR K. KAROTTKI, ESQ.**

Salvador K. Karottki, pursuant to 28 U.S.C. Section 1746, declares as follows:

1. My name is Salvador K. Karottki, and I have personal knowledge of the matters set forth in this Declaration and could and would testify competently thereto if called as a witness.

2. I am an attorney licensed to practice in the State of Illinois and before the Patent and Trademark Office (Reg. No. 53098). I am representing Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel") in the above-captioned cancellation proceeding.

3. On December 30, 2004, I spoke with Lloyd Prins ("Prins") on the telephone concerning Jackson/Charvel's Rule 37 letter to him. We spoke about several of Jackson/Charvel's discovery requests, including a simple request concerning Prins' first-use date of his SAN DIMAS mark. I asked Prins why he would not provide Jackson/Charvel with this basic information to which Jackson/Charvel was entitled. Prins took the position that these type of discovery requests concerning Prins' mark were "outside of the scope" of Jackson/Charvel's Petition for Cancellation. Prins and I discussed Prins' objections that certain of

Jackson/Charvel's discovery requests were allegedly "outside of the scope" of Jackson/Charvel's Petition for Cancellation, and it was clear to me that Prins disagreed with Jackson/Charvel's arguments in its Rule 37 letter that these type of discovery requests were appropriate.

4. Prins and I did not discuss every one of the points outlined in Jackson/Charvel's Rule 37 letter, however, as Prins stated that he had to leave and would be unable to continue the conversation. Prins indicated that he wanted additional time to review Jackson/Charvel's arguments. I requested that Prins respond later that day or on Friday, December 31. Prins declined and said he would be unable to do so. Prins indicated that he would not be able to respond to Jackson/Charvel's arguments in its Rule 37 letter until a date that fell after the start of the first testimony period. (The proceedings have since been suspended.) Prins said he would respond at a later date to all of Jackson/Charvel's discovery responses; however, I made no agreement on the telephone call concerning whether I would wait for this date. It was clear from our conversation that Prins disagreed with Jackson/Charvel's Rule 37 letter as to certain discovery requests and that Prins was not willing to engage in timely, good-faith Rule 37 discussion, so I made no commitment to forbear from bringing Jackson/Charvel's Motion to Compel.

5. Because Prins did not agree with Jackson/Charvel's arguments contained in its Rule 37 letter and continued to argue that certain of Jackson/Charvel's reasonable discovery requests were "outside of the scope" of Jackson/Charvel's Petition for Cancellation, I filed a Motion to Compel with the Trademark Trial and Appeal Board ("TTAB") on December 31, 2004. In that Motion, I specifically stated that "if the issues raised in Jackson/Charvel's Motion are subsequently resolved by agreement of the parties, Jackson/Charvel will inform the Board in writing of the issues in the Motion which no longer require adjudication."

6. On January 6, 2005, because I had not received any further response from Prins and because I wanted to continue to try to resolve the impasse between Prins and Jackson/Charvel, I called Prins. Prins stated that he was in the process of writing me a letter stating that he could not respond to my Rule 37 letter in writing. He requested that I allow him until February to respond. I told him that I could not agree to this. I also told him that the testimony period had started, and I needed his documents and responses. I mentioned to Prins that my answer might change if the TTAB suspended proceedings in order to review both Motions to Compel; however, I was very clear that I would not agree to Prins' request to wait until after the testimony period ended to respond to Jackson/Charvel's Rule 37 letter. I indicated to Prins that if he would not respond, we would just have to let the process play itself out at the TTAB.

7. On January 10, 2005, I received a letter from Prins making the same request that he made during the January 6 telephone call which I had already declined—to wait to respond to Jackson/Charvel's Rule 37 letter until February.

8. I filed and served Jackson/Charvel's Motion to Compel on December 31, 2004. Accordingly, Prins was required to respond to Jackson/Charvel's Motion to Compel by January 20, 2005. Prins did not respond.

9. On January 21, 2005, I received the TTAB's notice that proceedings had been suspended pending the ruling on the Motions to Compel. Attached hereto as Exhibit A is a true and correct copy of the TTAB's Suspension Notice, showing that I received the Notice on January 21, 2005.

10. As of this date, over two months after receiving Jackson/Charvel's Rule 37 letter, Prins has not responded in writing to this Rule 37 letter. The only substantive response that I received from Prins concerning Jackson/Charvel's Rule 37 letter was Prins' statements on

December 30, 2004, that certain of Jackson/Charvel's discovery requests were improper because they were "outside of the scope" of Jackson/Charvel's Petition for Cancellation. Prins did belatedly file a Response to Jackson/Charvel's Motion to Compel with the TTAB on February 14, 2005. However, in his Response, Prins did not address any of Jackson/Charvel's arguments, accept those with respect to Prins' answers to Jackson/Charvel's Admission Requests Nos. 11 and 38.

11. Prins said he did not file a Response until February 14, 2005, because the TTAB had suspended proceedings on January 14, 2005. (Prins' Response Brief at 4-5 ("Pursuant to 37 C.F.R. § 2.120(e)(2) and acting on the January 14, 2005 instructions from the TTAB, [Prins] withheld a reply to [Jackson/Charvel's] Motion To Compel because such a reply was not germane to the motion that was the source for the suspension. On February 10, 2005, [Prins] contacted the TTAB for instructions on this matter and was told that such a response would be accepted, as the TTAB would be considering all of the motions during the suspension.").) However, I did not receive notice of the TTAB's suspension until February 21, 2005—after Prins was required to respond to Jackson/Charvel's Motion to Compel.

12. On information and belief, Prins did not receive notice of the TTAB's suspension until after his Response was due. On information and belief, Prins used the TTAB's suspension of proceedings as a *post hoc* justification several weeks later for failing to respond to Jackson/Charvel's Motion to Compel.

13. Prins has not cooperated with Jackson/Charvel in trying to resolve discovery disputes. For example, Prins has failed to even substantively respond to Jackson/Charvel concerning the Confidentiality Stipulation and Protective Order that was sent to Prins in December 2004. Attached as Group Exhibit B are true and accurate copies of

correspondence and e-mails between me and Prins concerning the Confidentiality Stipulation and Protective Order.

14. I declare under penalty of perjury that the foregoing is true and correct and that those statements made on information and belief are believed to be true.

Executed on March 7, 2005.



SALVADOR K. KAROTTKI

# **EXHIBIT A**

RECEIVED

JAN 21 2005

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: January 14, 2005

Opposition No. 92042614

Jackson/Charvel Manufacturing,  
Inc.

v.

Prins, Lloyd A.

Nancy L. Omelko, Interlocutory Attorney:

Proceedings herein are suspended pending disposition of the motion to compel, except as discussed below. The parties should not file any paper which is not germane to the motion to compel. See Trademark Rule 2.120(e)(2), as amended effective October 9, 1998.<sup>1</sup>

This suspension order does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel, nor does it toll the time for a party to appear for a discovery deposition which had been duly noticed prior to the filing of the motion to compel. See *Id.* The motion to compel will be decided in due course.

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<sup>1</sup> A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

# **EXHIBIT B**

Lloyd A. Prins  
San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, CA 91208

RECEIVED

JAN 10 2005

January 7, 2005

Mr. Salvador K. Karottki  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603

Re: Cancellation No. 92042614

Dear Mr. Karottki,

As you have requested, I have reviewed your revisions to my Confidentiality Stipulation and Protective Order. As I have sought the assistance of the TTAB in this matter, I think it better that I not muddle things up by pursuing a different action ahead of their decision.

Sincerely,



Lloyd A. Prins  
San Dimas Guitar Company

**Karottki, Salvador K.**

---

**From:** Karottki, Salvador K.  
**Sent:** Tuesday, January 11, 2005 1:38 PM  
**To:** 'Lloyd Prins'  
**Subject:** Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

Dear Mr. Prins:

I am in receipt of your letter dated January 7, 2005, that references the Confidentiality Stipulation and Protective Order that we sent you. I left you a voicemail today concerning this letter, but I also wanted to send you an e-mail. In your letter of January 7, you stated that you had reviewed our revisions to the Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation"). However, rather than responding to our revisions, you stated, "As I have sought the assistance of the TTAB in this matter, I think it better that I not muddle things up by pursuing a different action ahead of their decision."

We do not understand your response. There is currently no motion before the Trademark Trial and Appeal Board ("TTAB") concerning a Confidentiality Stipulation. While you moved to compel certain answers to particular Interrogatory Requests that you served on Jackson/Charvel Manufacturing, Inc., there has been no request by either party to have the TTAB enter a Confidentiality Stipulation. Accordingly, you are not "pursuing a different action" or "muddl[ing] things up" by working with us on a Confidentiality Stipulation.

Furthermore, I am not aware that there is even a dispute concerning this issue. Both parties have indicated that there is a need for a Confidentiality Stipulation. You submitted a draft Stipulation and Protective Order to us, which appeared to be a form document. We responded by sending you our revisions. We provided you with electronic copies of the Confidentiality Stipulation in Microsoft Word format in both regular and red-line format (so you could easily see our revisions). We have been waiting to learn whether you have additional revisions or you find our draft of the Confidentiality Stipulation acceptable.

Please let us know what your position on this issue is. It is our hope that both parties, who recognize the need for a Confidentiality Stipulation, can work together to agree on language for the document. If you have revisions, please send them to us. If the Confidentiality Stipulation we sent you is acceptable, then let us coordinate to get the document signed. That way, both parties can exchange additional confidential documents. Both parties have a duty to try to work out any issues before involving the TTAB, and I would hope we could to come to an agreement on language.

Feel free to contact me if you have any questions about the foregoing or the Confidentiality Stipulation we sent you. It is my hope that we can "put this issue to bed" as soon as possible, and I look forward to working with you to do so.

Very truly yours,

Salvador K. Karottki, Esq.  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603-5802  
Phone: (312) 201-3861  
Fax: (312) 863-7861  
[www.goldbergkohn.com](http://www.goldbergkohn.com)

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3/7/2005

including attachments, if any.

**Karottki, Salvador K.**

---

**From:** Lloyd Prins [lprins@sandimasguitars.com]  
**Sent:** Tuesday, January 11, 2005 3:49 PM  
**To:** Karottki, Salvador K.  
**Subject:** Re: Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

Dear Mr. Karottki,

Thank you for your email. I apologize for missing your call earlier today.

I also apologize that this push to complete guitars make final preparations for the NAMM Show limits my time on this issue. The best I can offer you is to reply after the show.

Thank you for your understanding.

Lloyd Prins  
San Dimas Guitar Company

----- Original Message -----

**From:** Karottki, Salvador K.  
**To:** Lloyd Prins  
**Sent:** Tuesday, January 11, 2005 1:37 PM  
**Subject:** Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

Dear Mr. Prins:

I am in receipt of your letter dated January 7, 2005, that references the Confidentiality Stipulation and Protective Order that we sent you. I left you a voicemail today concerning this letter, but I also wanted to send you an e-mail. In your letter of January 7, you stated that you had reviewed our revisions to the Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation"). However, rather than responding to our revisions, you stated, "As I have sought the assistance of the TTAB in this matter, I think it better that I not muddle things up by pursuing a different action ahead of their decision."

We do not understand your response. There is currently no motion before the Trademark Trial and Appeal Board ("TTAB") concerning a Confidentiality Stipulation. While you moved to compel certain answers to particular Interrogatory Requests that you served on Jackson/Charvel Manufacturing, Inc., there has been no request by either party to have the TTAB enter a Confidentiality Stipulation. Accordingly, you are not "pursuing a different action" or "muddl[ing] things up" by working with us on a Confidentiality Stipulation.

Furthermore, I am not aware that there is even a dispute concerning this issue. Both parties have indicated that there is a need for a Confidentiality Stipulation. You submitted a draft Stipulation and Protective Order to us, which appeared to be a form document. We responded by sending you our revisions. We provided you with electronic copies of the Confidentiality Stipulation in Microsoft Word format in both regular and red-line format (so you could easily see our revisions). We have been waiting to learn whether you have additional revisions or you find our draft of the Confidentiality Stipulation acceptable.

Please let us know what your position on this issue is. It is our hope that both parties, who recognize the need for a Confidentiality Stipulation, can work together to agree on language for the document. If you have revisions, please send them to us. If the Confidentiality Stipulation we sent you is acceptable, then let us coordinate to get the document signed. That way, both parties can exchange additional confidential documents. Both parties have a duty to try to work out any issues before involving the TTAB, and I would hope we could come to an agreement on language.

Feel free to contact me if you have any questions about the foregoing or the Confidentiality Stipulation we sent

3/7/2005

you. It is my hope that we can "put this issue to bed" as soon as possible, and I look forward to working with you to do so.

Very truly yours,

Salvador K. Karottki, Esq.  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603-5802  
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3/7/2005

**Karottki, Salvador K.**

---

**From:** Karottki, Salvador K.  
**Sent:** Tuesday, January 18, 2005 9:12 PM  
**To:** 'Lloyd Prins'  
**Subject:** RE: Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

Dear Mr. Prins:

We are disappointed that you have been unable to respond to us concerning the Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation"). That said, our preference is to resolve this issue informally without involving the Trademark Trial and Appeal Board ("TTAB").

We hope that you will find the Confidentiality Stipulation we sent you acceptable and that both parties can sign the Confidentiality Stipulation without delay. That way, we can exchange additional confidential documents. As noted previously in correspondence, we are prepared to immediately send you Jackson/Charvel Manufacturing, Inc.'s confidential documents as soon as you sign the Confidentiality Stipulation.

We have already approached you multiple times to negotiate the Confidentiality Stipulation. While we want to work with you on agreeing to a Confidentiality Stipulation, we cannot wait indefinitely. You have requested additional time and, as a courtesy, we will give you additional time. However, if we do not receive a substantive response from you concerning the Confidentiality Stipulation on or before February 1, 2005, we will be forced to request that the TTAB act on this matter. We hope this will not be necessary and you will work with us on this matter.

Please give me a call if you have any questions or would like to discuss the Confidentiality Stipulation. We look forward to hearing from you shortly.

Very truly yours,

Salvador K. Karottki, Esq.  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603-5802  
Phone: (312) 201-3861  
Fax: (312) 863-7861  
[www.goldbergkohn.com](http://www.goldbergkohn.com)

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-----Original Message-----

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**Sent:** Tuesday, January 11, 2005 3:49 PM  
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**Subject:** Re: Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

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3/7/2005

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San Dimas Guitar Company

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We do not understand your response. There is currently no motion before the Trademark Trial and Appeal Board ("TTAB") concerning a Confidentiality Stipulation. While you moved to compel certain answers to particular Interrogatory Requests that you served on Jackson/Charvel Manufacturing, Inc., there has been no request by either party to have the TTAB enter a Confidentiality Stipulation. Accordingly, you are not "pursuing a different action" or "muddl[ing] things up" by working with us on a Confidentiality Stipulation.

Furthermore, I am not aware that there is even a dispute concerning this issue. Both parties have indicated that there is a need for a Confidentiality Stipulation. You submitted a draft Stipulation and Protective Order to us, which appeared to be a form document. We responded by sending you our revisions. We provided you with electronic copies of the Confidentiality Stipulation in Microsoft Word format in both regular and red-line format (so you could easily see our revisions). We have been waiting to learn whether you have additional revisions or you find our draft of the Confidentiality Stipulation acceptable.

Please let us know what your position on this issue is. It is our hope that both parties, who recognize the need for a Confidentiality Stipulation, can work together to agree on language for the document. If you have revisions, please send them to us. If the Confidentiality Stipulation we sent you is acceptable, then let us coordinate to get the document signed. That way, both parties can exchange additional confidential documents. Both parties have a duty to try to work out any issues before involving the TTAB and I would hope we could to come to an agreement on language.

Feel free to contact me if you have any questions about the foregoing or the Confidentiality Stipulation we sent you. It is my hope that we can "put this issue to bed" as soon as possible, and I look forward to working with you to do so.

Very truly yours,

Salvador K. Karottki, Esq.  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603-5802  
Phone: (312) 201-3861  
Fax: (312) 863-7861  
[www.goldbergkohn.com](http://www.goldbergkohn.com)

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**Karottki, Salvador K.**

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**From:** Karottki, Salvador K.  
**Sent:** Thursday, March 03, 2005 6:04 PM  
**To:** 'lprins@sandimasguitars.com'  
**Subject:** Jackson/Charvel v. Lloyd A. Prins -- Confidentiality Stipulation and Protective Order

Dear Mr. Prins:

In early January, you stated that you would get back to us "after the [NAMM] show" concerning whether the Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation") that Jackson/Charvel sent you is acceptable or whether you had any changes. It has been well over a month since the NAMM show ended, and we have heard nothing from you.

Please let us know if the Confidentiality Stipulation is acceptable so we can coordinate on executing the document. If you have suggested changes or questions about any part of the Confidentiality Stipulation, please let us know what they are so we can try to work together to get this document signed. As you know, both parties have objected to producing certain documents based on confidentiality issues. These documents could have been exchanged long ago if you would have signed the Confidentiality Stipulation. We have been prepared to do so for months, and we simply ask that you respond to us on this issue.

As noted below, our preference is to resolve this issue informally. Please contact me to discuss the Confidentiality Stipulation at your earliest convenience.

Very truly yours,

Salvador K. Karottki, Esq.  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603-5802  
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-----Original Message-----

**From:** Karottki, Salvador K.  
**Sent:** Tuesday, January 18, 2005 9:12 PM  
**To:** 'Lloyd Prins'  
**Subject:** RE: Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

Dear Mr. Prins:

We are disappointed that you have been unable to respond to us concerning the Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation"). That said, our preference is to resolve this issue informally without involving the Trademark Trial and Appeal Board ("TTAB").

We hope that you will find the Confidentiality Stipulation we sent you acceptable and that both parties can sign the Confidentiality Stipulation without delay. That way, we can exchange additional confidential documents. As

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noted previously in correspondence, we are prepared to immediately send you Jackson/Charvel Manufacturing, Inc.'s confidential documents as soon as you sign the Confidentiality Stipulation.

We have already approached you multiple times to negotiate the Confidentiality Stipulation. While we want to work with you on agreeing to a Confidentiality Stipulation, we cannot wait indefinitely. You have requested additional time and, as a courtesy, we will give you additional time. However, if we do not receive a substantive response from you concerning the Confidentiality Stipulation on or before February 1, 2005, we will be forced to request that the TTAB act on this matter. We hope this will not be necessary and you will work with us on this matter.

Please give me a call if you have any questions or would like to discuss the Confidentiality Stipulation. We look forward to hearing from you shortly.

Very truly yours,

Salvador K. Karottki, Esq.  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
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-----Original Message-----

**From:** Lloyd Prins [mailto:[lprins@sandimasguitars.com](mailto:lprins@sandimasguitars.com)]

**Sent:** Tuesday, January 11, 2005 3:49 PM

**To:** Karottki, Salvador K.

**Subject:** Re: Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

Dear Mr. Karottki,

Thank you for your email. I apologize for missing your call earlier today.

I also apologize that this push to complete guitars make final preparations for the NAMM Show limits my time on this issue. The best I can offer you is to reply after the show.

Thank you for your understanding.

Lloyd Prins  
San Dimas Guitar Company

----- Original Message -----

**From:** Karottki, Salvador K.

**To:** Lloyd Prins

**Sent:** Tuesday, January 11, 2005 1:37 PM

**Subject:** Jackson/Charvel v. Lloyd A. Prins -- Your Letter of January 7, 2005

Dear Mr. Prins:

I am in receipt of your letter dated January 7, 2005, that references the Confidentiality Stipulation and

3/7/2005

Protective Order that we sent you. I left you a voicemail today concerning this letter, but I also wanted to send you an e-mail. In your letter of January 7, you stated that you had reviewed our revisions to the Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation"). However, rather than responding to our revisions, you stated, "As I have sought the assistance of the TTAB in this matter, I think it better that I not muddle things up by pursuing a different action ahead of their decision."

We do not understand your response. There is currently no motion before the Trademark Trial and Appeal Board ("TTAB") concerning a Confidentiality Stipulation. While you moved to compel certain answers to particular Interrogatory Requests that you served on Jackson/Charvel Manufacturing, Inc., there has been no request by either party to have the TTAB enter a Confidentiality Stipulation. Accordingly, you are not "pursuing a different action" or "muddl[ing] things up" by working with us on a Confidentiality Stipulation.

Furthermore, I am not aware that there is even a dispute concerning this issue. Both parties have indicated that there is a need for a Confidentiality Stipulation. You submitted a draft Stipulation and Protective Order to us, which appeared to be a form document. We responded by sending you our revisions. We provided you with electronic copies of the Confidentiality Stipulation in Microsoft Word format in both regular and red-line format (so you could easily see our revisions). We have been waiting to learn whether you have additional revisions or you find our draft of the Confidentiality Stipulation acceptable.

Please let us know what your position on this issue is. It is our hope that both parties, who recognize the need for a Confidentiality Stipulation, can work together to agree on language for the document. If you have revisions, please send them to us. If the Confidentiality Stipulation we sent you is acceptable, then let us coordinate to get the document signed. That way, both parties can exchange additional confidential documents. Both parties have a duty to try to work out any issues before involving the TTAB, and I would hope we could to come to an agreement on language.

Feel free to contact me if you have any questions about the foregoing or the Confidentiality Stipulation we sent you. It is my hope that we can "put this issue to bed" as soon as possible, and I look forward to working with you to do so.

Very truly yours,

Salvador K. Karottki, Esq.  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
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Chicago, IL 60603-5802  
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## CERTIFICATE OF SERVICE

The undersigned, an attorney, certifies that on March 7, 2005, he caused a copy of Petitioner's **Reply in Support of Its Motion to Compel and to Test Sufficiency of Response to Admission Requests** to be served by U.S. Express Mail delivery upon the following:

Lloyd A. Prins  
San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, CA 91208

  
\_\_\_\_\_  
Salvador K. Karottki

TTAB

GOLDBERG KOHN

GOLDBERG KOHN BELL BLACK ROSENBLUM & MORITZ, LTD

March 7, 2005

sal.karottki@goldbergkohn.com  
direct phone: 312.201.3861  
direct fax: 312.863.7861

VIA EXPRESS MAIL NO. EL873829991US

BOX TTAB/NO FEE  
UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**Re: JACKSON/CHARVEL MANUFACTURING, INC. v. PRINS, LLOYD A. —  
CANCELLATION NO. 92042614**

Dear Sir or Madam:

Please find enclosed Petitioner's Reply in Support of Its Motion to Compel and to Test Sufficiency of Response to Admission Requests in connection with the above-referenced matter (Cancellation No. 92042614).

Please contact me if you have any questions or comments in this regard.

Very truly yours,



Salvador K. Karottki

SKK.ck

Enclosure

cc: Lloyd A. Prins  
Oscar L. Alcantara



03-07-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #66